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MARSHALL, GERSTEIN & BORUN LLP
6300 SEARS TOWER
233 S. WACKER DRIVE
CHICAGO, IL 60606

EXAMINER

TRAN, KHOA H

ART UNIT PAPER NUMBER

3634

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,434

Applicant(s)

PLEIMAN ET AL.

ST

Examiner

Khoa Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7-9,11-21 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 3,6,10,22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-9,11-18,20,21 and 24 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/25/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: Figures 1-5

Species II: Figures 6-8

Species III: Figure 9

Species IV: Figure 10

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mr. James P. Zeller on September 13, 2004 a provisional election was made without traverse to prosecute the invention of Species II, claims 1, 2, 4, 5, 7-9, 11-21, and 24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 6, 10, 22, and 23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

The drawings are objected to because Figure 3, reference numerals "30" and "26" and their lead lines should be deleted since these reference numerals are already used to reference the front end and the perimeter of the bottom panel (12). Figures 1 and 2 are objected to because they fail to show reference "G" and reference numeral "44" as mentioned on page 3, line 29 and on page 6, line 3. Figure 4 is objected to

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because it does not show reference numerals "46", "48" and "18" as described on page 6, line 14. Figures 1-3 are objected to because they fail to show reference numeral "52" as described on page 6, line 19. Figure 5 is objected to because it does not show reference numeral "46", "48" and "80" as described on page 8, line 24. Finally, the drawings are objected to because they fail to show reference numeral "76" and "78" as described on page 8, line 14. Correction is required.

It should be noted that corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

On page 7, line 18, "Fig. 2" should be changed to --Fig. 3-- because Figure 3 is the drawing that shows reference numeral "70" and other various mentioned reference numerals. The specification is objected to because the inconsistent use of terminology associates with reference numeral "144". Note on page 10, line 2, "a blind end or bottom surface" was referenced by numeral 144, then on line 7, reference numeral 144

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was used to reference "The angled surface" and on line 10, reference "144" was used again to reference "the tapered surfaced". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4, 5, 7-9, 11-21, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claims 1 and 17, it's unclear how the panels are constructed and arranged so that to counteract the tipping moment since no specific arrangement and/or structure has been set forth to accomplish the recited function. Claim 18 is misdescriptive and/or incomplete because no specific structure has been set forth to accomplish the recited function, thus it's unclear what element would cause the long handled tool to lean in a direction toward the back corner of the base panel.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 4, 5, 7-9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by W. N. Humphries et al. (U.S. Patent No. 2,835,503). Humphries et al. disclose a storage device for long handle tools comprising:

a base panel (54) having a plurality of receptacles (64, 66);

a plurality of risers (12) extending upward from the base panel and connecting to an upper panel (38) that has (38) a plurality of through openings (50, 52) formed therein; and

wherein the openings of the upper panel is generally offset vertically over the receptacles on the base panel such that the arrangement of the long handle tools (A, B, D) and moment negating portions (20) of the base panel are provided to counteract a tipping moment of the storage device. See Figures 1, 3, and 4.

Claims 1, 2, 4, 5, 7-9, 13, 14, 17, 18, 20, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hurt (U.S. Patent No. 6,460,709). Hurt discloses a corner storage device comprising an upper panel and a base panel (10) that each panel has a plurality of receptacles formed therein, the panels are interconnected with

one another by a plurality of risers (not showed) to formed a storage device, see column 3, lines 54-67 and column 4, lines 1-9; and

wherein the panels each has moment negating portions (68) to counteract a tipping moment of the storage device. See Figures 1-3. With respect to claims 4 and 20, it should be noted that a corner receptacle of the base panel is offset from the receptacle of the upper panel that is immediately adjacent to the corner receptacle.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over W. N. Humphries et al. (U.S. Patent No. 2,835,503) as applied to claims 1, 2-5, 7-9, and 11 above, and further in view of C. Wilcke (U.S. Patent No. 3,298,531). Wilcke teaches a base panel (55) of a storage device having a blind end surface (65) that is angled to urge an end of a long handle tool (23) to a tilt position. See Figures 1 and 2. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the base panel of Humphries et al. with the base panel that has angled blind end surfaces as taught by Wilcke in order to enable the end of a long handle tool to tilt and slightly diverge from the vertical position for the purpose of easy to remove the long handle tool from the storage device. With respect

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to claim 16, plastic is a well-known and readily commercially available material use in manufacture of a storage device. Accordingly, it would have been obvious to one ordinary skill in the art as a matter of engineering design choice to utilize plastic as the particular material to manufacture the storage device therefrom because it is well-within the level of skill in the art to utilize the known material according to its properties that they are known, i.e., to have a lightweight and durable storage device.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hurt (U.S. Patent No. 6,460,709) as applied to claims 1, 2, 4, 5, 7-9, 13, 14, 17, 18, 20, and 21 above, and further in view of Schier et al. (U. S. Patent No. 5,833,250). Schier et al. teach a base panel (14) that extends further forward than the front end of the upper panel (12). See Figure 2. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the base panel of Hurt with the provision of a base panel that extends further forward than the front end of the upper panel as taught by Schier et al. in order to provide additional surface area for storage.

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. Sweeney, J. T. mains, Jr., Williams, Houk, Jr. et al., F. F. Burtch, McGuinness, Fabiano, S. I. Goldstein, J. B. House, Utz, Chao, and O. Webber are cited to show a storage device that has similar configurations of design to applicants' claimed invention.

Allowable Subject Matter

Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Claim 19 is allowable because there is no prior art of record that teaches or suggests a corner storage device possessing the entire combination of features specified by the claims. In particular, there is no teaching or suggestion of "receptacles has a blind bottom surface that is angled downward toward the front end of the base panel" so that to cause the long handled tool received in the receptacles to lean and counteract at least part of the tipping moment. See Figure 8.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa Tran whose telephone number is (703) 306-3437. The examiner can normally be reached on Monday through Thursday from 9:30 A.M. to 7:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun, can be reached on (703) 308-2156. The fax phone number for this Group before a final Office action is (703) 872-9306 and after a final Office action is (703) 872-9327.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khoa Tran

September 13, 2004



LESLIE A. BRAUN
SUPERVISORY PATENT EXAMINER